

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

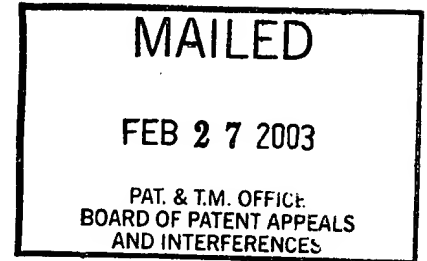
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN PETKOVSEK

Appeal No. 2002-1237
Application No. 09/394,228

ON BRIEF



Before FRANKFORT, STAAB, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, 7 through 9, 11 and 12. Claims 13 through 23 stand allowed. Claims 5, 6 and 10, the only other claims remaining in the application, have been objected to, but are indicated by the examiner to be allowable if rewritten in independent form (final rejection, page 5).

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As noted on page 1 of the specification, appellant's invention relates to a form for mailing an article requiring special service and a method of using same. More particularly, the invention is directed to an integral special service mailing assembly (e.g., Figs. 7-9) for mailing an article requiring special services and having a return receipt post card (108) having an integrally formed designator section (110), wherein the designator section is indicative of a special service, such as certified mail, insured mail, registered mail, return receipt for merchandise, and the like (specification, page 13-14). Also of importance to appellant is the fact that the special service mailing assembly should include shading and printing wherein the shading and printing are a single color, so as to avoid time-consuming printing using a plurality of colors, and the need for a printer having multiple color printing capabilities (specification, pages 2-3). Independent claims 1 and 9 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix to appellant's brief, is attached to this decision.

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The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Walz	5,664,725	Sep. 9, 1997
Petkovsek	5,697,648	Dec. 16, 1997

Claims 1 through 3, 7 through 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walz.

Claims 4 and 12 stand further rejected under 35 U.S.C. § 103 as being unpatentable over Walz in view of Petkovsek.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding those rejections, we make reference to the final rejection (Paper No. 7, mailed June 4, 2001) and examiner's answer (Paper No. 12, mailed February 13, 2002) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 11, filed January 15, 2002) and reply brief (Paper No. 15, mailed April 23, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

In setting forth the rejection of claims 1 through 3, 7 through 9 and 11 under 35 U.S.C. § 103(a) based on Walz, the examiner has taken the position that Walz (e.g., Fig. 1) discloses, *inter alia*, a special service mailing assembly comprising a label including a return post card (70) integrally formed with a designator section (73) that is contained within the exterior sides (24, 26) that define the post card. The examiner concedes (final rejection, page 3) that Walz does not disclose a designator section indicative of a special service, or label shading and printing wherein the shading and printing are a single color. In attempting to account for the above-noted differences, the examiner has urged that

it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and

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postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401 (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate (final, pages 3-4).

In addition, the examiner contends (final rejection, page 4) with particular regard to claims 1 and 9, that

matters related to the choice of ornamentation (color and shading) producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431.

As further commentary addressing claims 9 and 11, the examiner has indicated (final rejection, page 3) that the method for preparing a mailpiece for delivery "is inherently taught by Walz."

In our opinion, the fundamental flaw in the examiner's position is that he has disregarded the claimed subject matter as a whole by attempting to distill appellant's claimed invention directed to a special service mailing assembly having particularly recited structural features down to merely what the

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examiner has characterized as printed matter and ornamentation, which purportedly do not distinguish the claimed invention from the prior art in terms of patentability.

Even if we were willing to accept the examiner's position that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to print indicia representing a special service, such as certified mail, COD, or return receipt, in the area (73) of the post card in Walz Figure 1 used for indicating "other services" (col. 4, line 46), we find no basis for either the examiner's interpretation of the "shading and printing" limitation of independent claims 1 and 9 or the examiner's attempt to disregard those limitations as being merely a "choice of ornamentation producing no mechanical effect or advantage" (answer, pages 4-5).

What the examiner has seemingly lost sight of is the fact that before the USPTO, when evaluating claim language during examination of an application, the examiner is required to give the terminology of the claims its broadest reasonable interpretation *consistent with the specification*, and to remember that the claim language cannot be read in a vacuum, but instead

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must be read in light of the specification as it would be interpreted by one of ordinary skill in the pertinent art. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Bond, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). When that standard is applied to the present application, it is clear to us that the requirement in claims 1 and 9 for the shading and printing of the label to be "a single color" means that both the shading and printing are the same color, e.g., green for designating certified mail or brown for designating return receipt for merchandise (see appellant's specification, pages 2-3 and 19). Thus, the examiner's interpretation set forth in the answer (pages 4-5) is untenable, unreasonable and in error.

With regard to the examiner's apparent use of a *per se* rule such as that seemingly derived from In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947), we direct the examiner's attention to In re Ochiai, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) wherein the Federal Circuit has held that the

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claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. § 103 since such purported rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103. Moreover, we observe that the fact situation in In re Seid is entirely different than that in the present application, wherein providing the shading and printing on the label in a single color serves an important purpose (i.e, identifying the specific special service that a particular mailing assembly is to be used for) and provides an important advantage over the prior art (i.e, simplifying the printing process required by allowing use of a single color print cartridge, ribbon or the like). Again, we direct attention to appellant's specification at pages 2 and 3, and at page 19.

In light of the foregoing, we find that the examiner has failed to set forth a *prima facie* case of obviousness, and thus we will not sustain the rejection of claims 1 through 3, 7 through 9 and 11 under 35 U.S.C. § 103(a) based on Walz.


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We next look to the examiner's rejection of dependent claims 4 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Walz and Petkovsek. We will not sustain this rejection either. Stated simply, there is nothing in Petkovsek which provides for that which we have found above to be lacking in the basic reference to Walz.

To summarize, we note that each of the examiner's rejections of the claims on appeal under 35 U.S.C. § 103(a) has not been sustained, and that the examiner's decision as articulated in the final rejection and answer is accordingly reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


LAWRENCE J. STAAB
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
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Attachment

1. A special service mailing assembly comprising:

a label having a front side and a back side wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the designator section is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color.

9. A method for preparing a mailpiece for delivery by a special service, the method comprising the steps of:

providing a label having a front side and a back side wherein the label includes a return postcard integrally formed with a designator section indicative of a special service wherein the designator is contained completely within exterior sides that define the return postcard and further wherein the label includes shading and printing wherein the shading and printing are a single color;

providing at least one anchor portion on an exterior side of the return postcard wherein the anchor portion has a back side and further wherein the back side of the anchor portion includes an adhesive;

removing a backing strip disposed over the adhesive; and

attaching the label to a mailpiece to effect delivery by a special service.

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